



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/587,384

06/08/2007

Uwe Skultety-Betz

10191/4513

7300

26646

7590

11/29/2011

KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

EXAMINER

IGYARTO, CAROLYN

ART UNIT

PAPER NUMBER

2884

MAIL DATE

DELIVERY MODE

11/29/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/587,384	Applicant(s) SKULTETY-BETZ ET AL.	
	Examiner CAROLYN IGYARTO	Art Unit 2884	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 17,18,20-33 and 35-38 is/are pending in the application.
- 5a) Of the above claim(s) 26-33 and 37 is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 17,18,20-25,35,36 and 38 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☒ The drawing(s) filed on 30 September 2011 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Response to Amendment

1. The amendment filed on 30 September 2011 was accepted and entered. Accordingly, claims 17, 20, and 36 have been amended. Claims 1-16, 19, and 34 have been cancelled. Claim 38 has been newly added. Thus, claims 17-18, 20-33, and 35-38 are currently pending in this application. Claims 26-33 and 37 have been withdrawn. Changes have been made to the drawings and specification.
2. In view of the amendment, received 30 September 2011, the previous objection to the drawings has been withdrawn.
3. In view of the amendment, received 30 September 2011, the previous rejections under 35 USC 112 regarding “unequivocal” have been withdrawn.
4. In view of the amendment, received 30 September 2011, the previous rejections under 35 USC 102 and 103 have been withdrawn. The prior art of record does not disclose or reasonably suggest, along with the other claimed limitations, a handheld measuring device for localizing at least one object in a medium comprising: namely, a radar sensor configured to provide information including identification of a material of the at least one object to the at least one photometric sensor and the at least one photometric sensor is optimized on the basis of the information obtained from the radar sensor.
5. In view of the amendment, received 30 September 2011, the previous double patenting rejection has been withdrawn, because appl. 10/589,401 (now US pat. 7,965,794) does not include the claimed feature of a radar sensor providing

identification of a material of the at least one object and that information being the basis of optimization of the at least one photometric sensor.

Response to Arguments

6. Applicant's arguments filed 30 September 2011 have been fully considered but they are not persuasive.

7. Applicant argues that “optimizing one photometric sensor based on the identification of a material of the at least one object obtained from the at least one further sensor is supported and enabled by the specification” and points to page 6, lines 13-26; page 8, line 22 – page 9, line 6; page 13, lines 5-21; page 22, line 25 – page 23, line 3 of the specification of the instant application. Page 6, lines 13-26 appears to provide that the system is optimized by the processing system averaging out the signals of the air inclusions measured by the radar sensor. The specification lacks adequate guidance how to program the processing system to do such. Page 6 states that “[i]n this fashion the radar sensor can be operated in optimized fashion,” but there was not discussion how to change the operation of the radar sensor to optimize its operation. page 8, line 22 – page 9, line 6 discuss writing into the driving system of the individual sensors various programs, such as a “metal program”, a “hollow tile program”, and a “plastic program” so that when one or more sensors give indications of a specific material then all the sensors are set to that program and the sensor driving and evaluation are optimized for the material. This discloses that the driving and evaluation is optimized not the sensor, additionally, the specification lacks adequate direction or guidance for one of ordinary skill to write into the driving system appropriate programs

or how to perform such functions. Page 13, lines 5-21 discusses individual measurement signals of the sensors are evaluated and compared to one another and thereupon individual sensors are optimized as a function of the measurement results of the other sensors. Also discussed is to write programs into the driving system and when certain sensors provide indications as to a specific material, then all the sensors are switches to that program, which optimizes the measurement results. This does not provide adequate guidance or direction how to program appropriately or perform such functions nor is how to optimize a sensor itself discussed. Page 22, line 25 – page 23, line 3 discusses generally that with the exemplary method it is possible to optimize a sensor on the basis of information about the enclosed object obtained by way of the other sensors, but adequate guidance or direction how to do so has not been disclosed.

8. Additionally, there is support in the original for optimizing a first signal to the specific measurement situation based on the measurement results of a second sensor, which can be the indication of a specific material, but there is not original support for the identification of the material to be an identification of a material of the at least one object, which is “enclosed in a medium.”

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 2884

10. Claims 17-25, 35-36, and 38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. One of ordinary skill in the art would not have been enabled to make and/or use the invention because it has not been adequately disclosed how to optimize the at least one photometric sensor based on the information obtained from the at least one further sensor.

11. Claims 17-25, 35-36, and 38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is support in the original disclosure for optimizing a first signal to the specific measurement situation based on the measurement results of a second sensor, which can be the indication of a specific material. However, “the information on which the optimization is based includes an identification of a material of the at least one object”, which is “enclosed in a medium” does not appear to be originally disclosed.

12. Claim 17-25, 35-36, and 38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application

Art Unit: 2884

was filed, had possession of the claimed invention. A radar sensor providing information including identification of a material of the at least one object does not appear to be originally disclosed.

13. Claim 17-25, 35-36, and 38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. One of ordinary skill would not have been enabled to make and/or use the invention, because how to configure a radar sensor to provide information including an identification of a material has not been adequately disclosed.

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 17-25, 35-36, and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

16. It is unclear how the structures of the claims invention are further limited by the functional recitations provided in the claims. If Applicant is intending to further limit the structure of the claimed invention; then the Examiner recommends amending the claims to clearly recite such further limitations. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (see MPEP 2106(II)(c)). While

features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function (see MPEP 2114).

17. Claim 17, lines 9-10 recite “the at least one further sensor is configured to provide information including identification of a material of the at least one object.”

Claim 17, lines 12-13 recite “the at least one photometric sensor is optimized on the basis of the information obtained from the at least one further sensor.” It is unclear whether or not the identification of the material is necessitated for the optimization. For purposes of a prior art search, the Examiner has interpreted optimization is based on identification of the material.

Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CAROLYN IGYARTO whose telephone number is (571)270-1286. The examiner can normally be reached on Monday - Thursday, 7:30 A.M. to 5 P.M. E.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Porta can be reached on (571) 272-2444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David P. Porta/
Supervisory Patent Examiner, Art
Unit 2884

CI

Application/Control Number: 10/587,384
Art Unit: 2884

Page 9